I. Rejection of claims 1, 6, 8-14, 18, 20-21, 24-27, 30-31, 36, 38-44, 48, 50-51, 55-57, 60-61, 66, 68-74, 78, 80-81, 85-87 and 90-99 under 35 U.S.C. § 103(a) as being unpatentable over Poole et al. (USP 6,006,242)

Claim 1, for example, is directed to a method for creating a compilation from a collection of content stored in a database. The claim includes presenting a plurality of selectable objects to a user and that each object represents a subset of the collection of content. The claim also requires that in response to selection by a user of one or more of the objects, creating a hierarchical compilation of the content represented by each selected object.

The Examiner cites Poole for allegedly teaching many of the elements of claims 1, 31 and 61. The Examiner admits, however, that Poole does not teach creating a hierarchical compilation of the content represented by each selected object in response to selection by a user of one or more of said objects. The Examiner asserts that in Poole, in some cases, an entity reference that has been resolved may include one or more entity references which require resolving. In such a case, any remaining unresolved entity references that are nested within the resolved entity reference are resolved. After resolving all the entity references, a document can be produced. Therefore, the Examiner asserts that it would have been obvious to modify Poole to have hierarchical grouping and editing in order to resolve the nested entity references into a predefined document.

In Poole, a document developer specifies content to be included in a document. Each of the constituent portions of the document is associated with an entity reference which a developer uses to select content. See col. 5, lines 3-11. An entity reference is read from a document

instance and compared to entity identifiers provided in a catalog containing a plurality of entity identifiers. Each of the entity identifiers in the catalog is associated with an entity resolution process. An inference engine or other entity resolving processor is invoked to effectuate the resolution process associated with a matching entity identifier. The inference engine or entity resolving processor resolves the entity reference to a resolved entity, such as a component of text or graphics to be included in a final document. A resolved entity may contain one or more embedded entity references which are similarly resolved. See col. 2, lines 13-28.

Although nested entity references may exist for a particular document being created, the resolved entity references do not result in a hierarchical compilation of content. In particular, an entity reference and a nested entity reference may result in different content being included in the document, such as text or graphics. It is respectfully submitted that merely because Poole discloses that entity references might be nested, does not mean that the resulting compilation of content represented by the object (e.g. an entity reference) is a hierarchical compilation, since Poole does not teach or suggest such a hierarchical compilation.

For at least the above reasons, claims 1, 31 and 61 and their dependent claims should be deemed patentable. Since claims 30, 60 and 90 recite similar elements, they should be deemed patentable for the same reasons.

II. Rejection of claims 2-3, 29, 32-33, 59, 62-63 and 89 under 35 U.S.C. § 103(a) as being unpatenable over Poole in view of Guck (USP 5,864,870) and ksinclair.com (Free E-books You Can Download)

Claims 2-3, 29, 32-33, 59, 62-63 and 89 should be deemed patentable by virtue of their dependency to independent claims 1, 31 and 61 for the reasons set forth above. Moreover, the combination of Guck and ksinclair.com do not cure the deficiencies of Poole.

III. Rejection of claims 4-5, 7, 19, 28, 34-35, 37, 49, 58, 64-65, 67, 79 and 88 as being unpatentable under 35 U.S.C. § 103(a) over Poole in view of ksinclair.com

Claims 4-5, 7, 19, 28, 34-35, 37, 49, 58, 64-65, 67, 79 and 88 should be deemed patentable by virtue of their dependency to independent claims 1, 31 and 61 for the reasons set forth above. Moreover, ksinclair.com does not cure the deficiencies of Poole.

IV. Rejection of claims 15-17, 22-23, 45-47, 52-54, 75-77 and 82-84 under 35 U.S.C. § 103(a) as being unpatentable over Poole in view of Duwaer et al. (USP 5,959,627)

Claims 15-17, 22-23, 45-47, 52-54, 75-77 and 82-84 should be deemed patentable by virtue of their dependency to independent claims 1, 31 and 61 for the reasons set forth above. Moreover, Duwaer does not cure the deficiencies of Poole nor is the combination of Duwaer with Poole obvious.

V. Rejection of claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 under 35 U.S.C. § 103(a) as being unpatentable over The McGraw-Hill Companies (McGraw Hill Primis Custom Publishing)

Claims 1, 6-8, 11-23, 25-28, 30-31, 36-38, 41-53, 55-58, 60-61, 66-68, 71-83, 85-88, 90-91, 94 and 97 have been rejected under § 103(a) as being unpatentable over McGraw-Hill Primis Custom Publishing (www.mhhe.com/primis), allegedly archived circa 1998, via the Wayback Machine (www.archive.org) (hereinafter McGraw).

Applicant respectfully submits the following in traversal of the rejections, assuming, only for the purposes of argument, that the McGraw reference qualifies as prior art under § 102.

The Examiner asserts that McGraw teaches the elements of claims 1, 31 and 61 except that it does not explicitly teach creating a hierarchical compilation. However, the Examiner takes the position that a user can combine a selection from any discipline in any order and by organizing the complimentary custom book into orders, the user can compile a complimentary custom book that is a hierarchical compilation.

In order to render a claim obvious, the prior art must teach or suggest making the asserted modification to the primary reference. Here, the Examiner merely asserts that "a user can combine [a] selection from any discipline in any order." In essence, the Examiner appears to take the position that merely because a user could take certain actions it would have been obvious to do so. It is respectfully submitted, however, that the teaching or suggestion to make the asserted modification must be found in the prior art and no such suggestion has been shown.

Accordingly, it is respectfully submitted that independent claims 1, 31 and 61 are not rendered unpatentable. Since claims 30, 60 and 90 recite similar elements, they should be deemed patentable for the same reasons.

VI. Rejection of claims 2-3, 29, 32-33, 59, 62-63 and 89 as being unpatentable over McGraw in view of Mortimer et al. (USP 6,091,930)

Claims 2-3, 29, 32-33, 59, 62-63 and 89 should be deemed patentable by virtue of their dependency to independent claims 1, 31 and 61 for the reasons set forth above. Moreover, Mortimer does not cure the deficiencies of McGraw.

VII. Rejection of claims 4-5, 34-35 and 64-65 under 35 U.S.C. § 103(a) as being unpatentable over McGraw in view of ksinclair.com

Claims 4-5, 34-35 and 64-65 should be deemed patentable by virtue of their dependency to independent claims 1, 31 and 61 for the reasons set forth above. Moreover, ksinclair.com does not cure the deficiencies of McGraw.

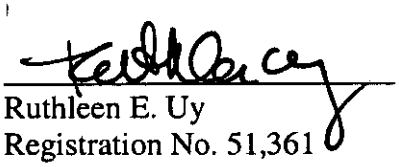
VIII. Rejection of claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 under 35 U.S.C. § 103(a) as being unpatentable over McGraw in view of Poole

Claims 9-10, 24, 39-40, 54, 69-70, 84, 92-93, 95-96 and 98-99 should be deemed patentable by virtue of their dependency to independent claims 1, 31 and 61 for the reasons set forth above. Moreover, Poole does not cure the deficiencies of McGraw.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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Date: September 3, 2004